

## **REMARKS**

This amendment and the accompanying Request for Continued Examination are being filed responsive to the Notification of Non-Complaint Appeal Brief dated August 29, 2005, and to the Advisory Action Before the Filing of an Appeal Brief dated June 6, 2005.

As an initial matter, Applicant thanks the Examiner for his time and participation in a telephonic discussion with Applicant's authorized representative on September 19, 2005. During this conversation, prior art documents submitted in Applicant's Supplemental IDS, and in two third-party Protests were discussed. As the Examiner could not discern pertinent features in some of these prior art documents, it was agreed that the Examiner would review these documents and request additional copies of those documents which were of poor quality. Applicant has previously submitted clear copies of all photographs in Applicant's supplemental IDS, and copies were also included in the third-party Protests. However, we understand that some of the copies that reached the Examiner were not entirely legible. Therefore, with this document Applicant is submitting a complete set of legible color copies. The dates appear to be accurate. Applicant makes no representations as to the accuracy of the lead lines or language designating various parts.

These remarks, and the above amendments, were previously submitted in Applicant's Response to final Office action dated May 24, 2005. As stated in the Advisory Action Before the Filing of an Appeal Brief dated June 6, 2005, the Examiner concluded that the proposed amendments raised new issues requiring further consideration. Accordingly, these same amendments are being submitted for further consideration in this Request for Continued Examination. Applicant acknowledges that,

under 37 C.F.R. § 1.114(d), filing this Request for Continued Examination after a Notice of an Appeal, but prior to a decision on the appeal, will serve to withdraw the appeal and reopen prosecution of this application before the Examiner.

Prior to entry of the above amendments, claims 1-52 were pending in the application. In the final Office action dated December 1, 2004, the Examiner allowed claims 1-22 and 52, and indicated that claims 25, 32, and 45 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claims 23, 24, 26-31, 33-44 and 46-51 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,248,042 to Kuhmonen in view of GB Patent Application No. 2200613 to Jenkins et al. In addition, claims 1-52 were objected to under 37 CFR § 1.173 as being of improper form.

Further, these remarks, and the above amendments, are responsive to two Protests recently filed with the USPTO under 37 CFR § 1.182. A first Protest was filed on February 11, 2005 on behalf of an unnamed party and a second Protest was filed on February 28, 2005 on behalf of Wildcat Mfg. These two Protests (herein collectively referred to as "Protests"), allege that the subject matter of the present reissue application is unpatentable in light of prior art references including:

Eliminator Trommel by Enviroquip Systems Inc. ("Eliminator"),  
Royer 616/616MP Trommel by Royer Mfg. ("Royer"),  
Landscaper Trommel by Re-Tech Industries, Inc. ("Landscaper"),  
U.S. Patent No. 5,285,905 to Laprade ("Laprade"),  
Cedarapids 5348-VCF-FS Impact Breaker, Cedarapids 5460 MTP Plant Parts Manual, and Cedarapids Portable & Radial Staking Conveyor by Cedarapids Mfg. (collectively referred to hereafter as "Cedarapids"),  
Remu Trommel by Lepkopa Oy of Finland ("Remu"),  
U.S. Patent No. 5,248,042 to Kuhmonen ("Kuhmonen"),  
Diamond Z Device by Diamond Z Mfg. ("Diamond Z"),  
U.S. Patent No. 4,997,135 to Zehr ("Zehr"),  
U.S. Patent No. 2,609,115 to Oklejas ("Oklejas"),  
U.S. Patent No. 5,577,618 to Rafferty ("Rafferty"), and

U.S. Patent No. 4,058,198 to O'Neil ("O'Neil").

Applicant has studied these Protests, and the references cited therein, and has concluded that the references have no effect on the patentability of the claims allowed by the Examiner in the previous Office action. While Applicant strongly disagrees with the allegations of unpatentability contained within these Protests, Applicant has amended some of the other allowed claims to more particularly distinguish the inventive subject matter of this application over the prior art cited in the recently received Protests. Due to the timing of these Protests, Applicant respectfully asserts these amendments are properly made after the final Office action under 37 C.F.R. §1.116 (b), as well as under other provisions in the Rules.

By the above amendments, allowable claims 1, 3, 5, 7, 25, 32, 45, and 52 are amended, and claims 2, 23, 24, 26-31, 33-44 and 46-51 are cancelled without prejudice. In view of the preceding amendments and the following remarks, Applicant respectfully requests reconsideration of the application and allowance of all pending claims.

#### **Amendments to Original Patent Claims**

Original claims 1, 3, 5, 7, and 25 are amended.

Claim 1 is amended to further distinguish the invention of the current application from the prior art, to correct typographical errors, and to include markings pursuant to 37 CFR § 1.173(d). Amended claim 1 incorporates the elements of original patent claim 2. Dependent original patent claim 2 has been cancelled without prejudice. As both original claim 1 and claim 2 were indicated as being allowable, the inclusion of allowed claim 2 elements into original claim 1 only serves to further distinguish the

portable trommel of amended claim 1, and the allowed dependent claims 3-22, from the prior art.

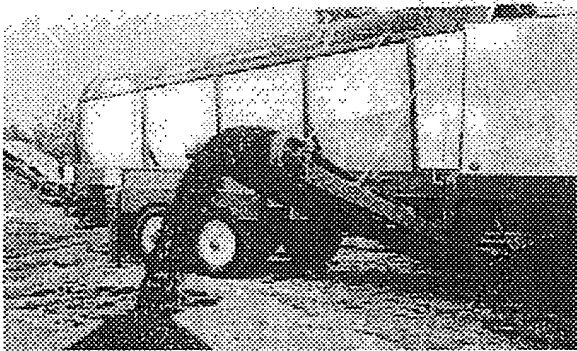
Amended claim 1 is reproduced below for the Examiner's convenience:

A portable trommel comprising:  
a chassis, including support wheels at one end thereof for movement of the portable trommel;  
a trommel rotatably mounted on the chassis and having an input end, an output end, and a trommel screen;  
input means for supplying material to be screened to the input end of the trommel, the input means being mounted on the chassis adjacent the input end of the trommel;  
output means for collecting material passing through the trommel screen, the output means being mounted on the chassis, below the trommel; and  
a stockpiling conveyor mounted on the chassis and having a lower end for receiving screened material from the output means and having an upper end for discharging screened material to form a stockpile, wherein the stockpiling conveyor comprising a first lower part pivotally attached to the chassis and a first upper part, which is pivotally attached to the first lower part, the first lower and the first upper parts being movable between an extended, operational position, in which the stockpiling conveyor extends upwardly and outwardly from the chassis and a retracted position for transportation, in which the first lower part is at an angle to the first upper part and the first upper part extends over the chassis, and further wherein the first lower part of the stockpiling conveyor has a lower end mounted to the chassis for rotation about a vertical axis, to enable the stockpiling conveyor to form an arc-shaped stockpile.

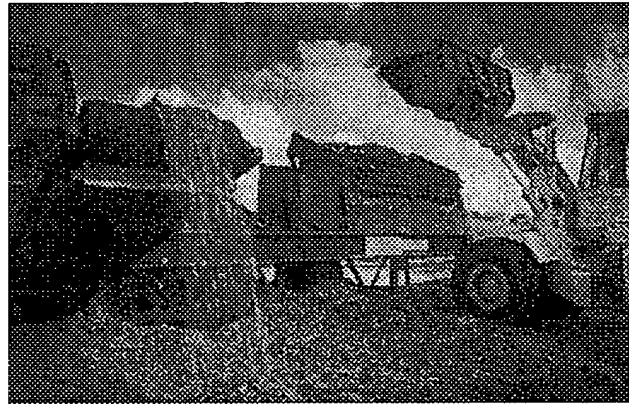
As stated, claim 1 recites a portable trommel including a chassis, a trommel, a trommel output means, and a stockpiling conveyor which is mounted to the chassis, receives screened material, and is capable of rotation about a vertical axis to form an arc-shaped stockpile.

None of the prior art references cited in the Protests disclose or suggest the trommel of claim 1. While the Eliminator, Royer, Remu, and Landscaper disclose trommels mounted onto a frame suitable for transport, these references all at least lack a mounted retractable conveyor that receives screened material which is rotatable about a vertical axis and is capable of forming an arc-shaped stockpile. As shown below, the Eliminator, Royer and Remu devices each include a stockpiling conveyor

located on the side of the trommel, which are incapable of the rotation about a vertical axis required to form an arc-shaped pile. Similarly, the conveyor of the Landscaper device is also incapable of forming an arc-shaped stockpile by rotation about a vertical axis. For at least these reasons, claim 1 is not anticipated by any of the Protest-cited prior art references.



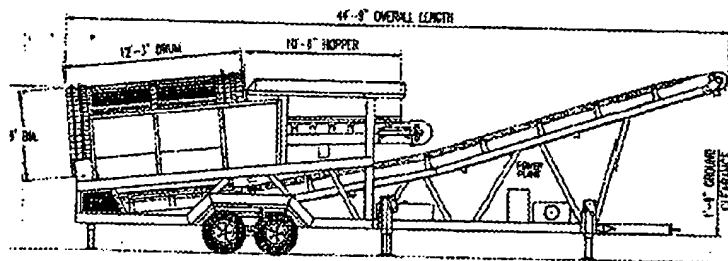
Eliminator Photo from Protests



Royer Photo from Protests



Remu Photo from Protests



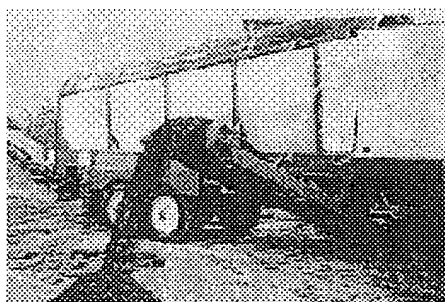
Landscaper Drawing from Protests

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Furthermore, none of the references cited in either of the Protests teach or suggest the trommel recited in claim 1. The Protests allege that claim 1 is rendered obvious by an array of fanciful combinations involving the above listed references, but

none of these are based upon teachings then available in the prior art. While each element of claim 1 may have existed in isolation in at least one of the cited references, the assemblages argued in the Protests are based upon the teachings of the claimed inventions. As will be discussed below, this type of hindsight reconstruction is of course not permitted under proper §103 analysis.

Suggestions in the Protests include combining parts of a portable trommel reference with parts of a conveyor reference. For example, both of the Protests concluded that claim 1 would have been rendered obvious at the time the invention was made by combining a portable trommel with a side-displaced conveyor, such as the Eliminator, Royer, Remu, or Landscaper devices shown above, with one or more of the Rafferty, Zehr, Laprade, or Kuhmonen secondary references disclosing a conveyor. For convenience, the Eliminator trommel and the Rafferty conveyor are shown below.



Eliminator Photo from Protests

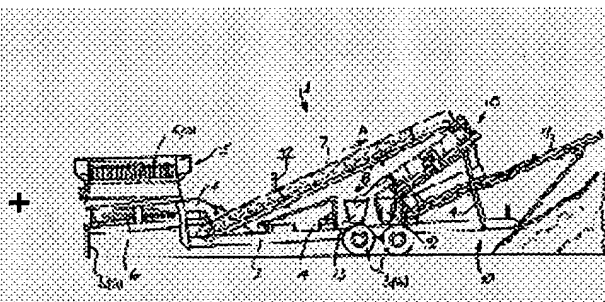


Figure from Rafferty

An attempt to combine the Eliminator screen and the Rafferty conveyor would result in an inoperable piece of equipment. This alleged combination would have resulted in a trommel with a radial stockpiling conveyor positioned on one side of the chassis. As can be appreciated by the above Eliminator Photo showing the Eliminator

screen as existed at the time of the invention, there was limited space under the side of a portable trommel chassis. There was not adequate space to house the base of a radial stockpiling conveyor and the configuration of belts needed to connect with a radial stockpiling conveyor. Therefore such a combination would have been inoperable.

In applying 35 U.S.C. § 103, the prior art references must suggest the desirability, and thus, the obviousness of making the combination. In other words, there must be some teaching or suggestion to combine the cited references. Such a requirement serves to prevent against the benefit of impermissible hindsight vision afforded by the disclosure. See In re Paulsen, 30 F.3d 1475, 1482 (Fed. Cir. 1994) and Hodosh v. Block Drug Co., Inc., 786 F.2d 1136, 1143 (Fed. Cir. 1986). The Federal Circuit further clarified this teaching requirement of obviousness in McGinley v. Franklin Sports, Inc., 262 F.3d 1339, 60 USPQ2d 1001 (Fed. Cir. 2001) in stating that:

We have noted elsewhere, as a 'useful general rule,' that references that teach away cannot serve to create a prima facie case of obviousness. If references taken in combination would produce a 'seemingly inoperative device,' we have held that such references teach away from the combination and thus cannot serve as predicates for a prima facie case of obviousness.

Id. at 1354 (citations omitted). Thus, it is impermissible to consider an inoperable combination of references as rendering a claim obvious under 35 U.S.C. § 103.

In applying these legal standards, Applicant disagrees with the Protests' contentions that the combination of the Protest references would have rendered claim 1 obvious. None of the references listed above, nor the collective disclosures of all of the references, provide the required teaching or motivation to produce the combination proposed in amended claim 1. Impermissible hindsight reconstruction prevents the very picking and choosing elements of various references that is suggested in the Protests.

Ignoring the fact that these references do not suggest the specific portable trommel of claim 1, the references all fail to even suggest that such a combination involving a portable trommel and a rotatable, retractable, stockpiling conveyor configured to receive screened material would be desirable to achieve the device of amended claim 1.

For at least these reasons, independent claim 1 is neither anticipated nor obvious in light of any prior art references of record. Thus, claim 1 is currently in condition for allowance. As claims 3-22 are dependent on allowable claim 1, these claims are also in condition for allowance.

Claim 25 is amended to be written in independent form including all the limitations of the previously presented base and intervening claims, and to include markings pursuant to 37 CFR § 1.173(d). As indicated by the Examiner in the previous Office action, claim 25 is now in condition for allowance.

### **Amendments to Added Claims**

As indicated above, added claims 32, 45 and 52 are amended.

Added claim 32 is amended to be in independent form including all the limitations of the previously presented added base and intervening claims, to further distinguish the subject of this present reissue application from the prior art, and to include markings pursuant to 37 CFR § 1.173(d). As amended, claim 32 recites the elements presented in original patent claim 2, namely that a conveyor is mounted on the frame assembly “for rotation about a vertical axis”, so as to enable the conveyor “to form an arc-shaped stockpile.” By this amendment, claim 32 is limited to more specifically distinguish the trommel of the present reissue application over the prior art references cited in the Protests. Accordingly, this amendment strengthens the patentability of added claim 32,



and as indicated by the Examiner in the previous Office action, rewritten claim 32 is in condition for allowance.

Claim 45 is amended to be written in independent form including all the limitations of the previously presented added base and intervening claims, and to include markings pursuant to 37 CFR § 1.173(d). As indicated by the Examiner in the previous Office action, claim 45 is now in condition for allowance.

Claim 52 is amended to correct typographical errors, to further distinguish the subject of this present reissue application from the prior art, and to include markings pursuant to 37 CFR § 1.173(d). Elements of original allowed claim 2 reciting a trommel capable of rotation about a vertical axis are incorporated into amended claim 52 to more clearly distinguish the trommel recited in claim 52 from the prior art references. As discussed above in reference to amended claims 1 and 32, the amendment to claim 52 does not add any new matter and only serves to strengthen the patentability of this allowable claim. Accordingly, amended claim 52 is in condition for allowance.

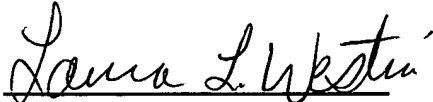
In accordance with 37 C.F.R. 1.173(c), a Claims Status List, including support for any claim changes, has been included in this response.

Further, an executed supplemental reissue oath/declaration under 37 CFR § 1.175(b) (1) acknowledging these claim amendments is enclosed with this response.

Applicant believes that this application is now in condition for allowance. Accordingly, applicant respectfully requests that the Examiner issue a Notice of Allowability covering all pending claims. If the Examiner has any questions, or if a telephone interview would in any way advance prosecution of the application, please contact the undersigned attorney of record.

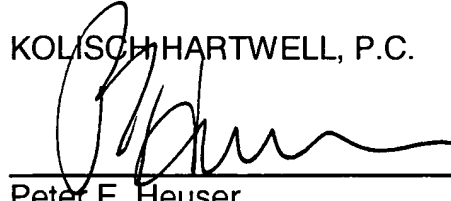
**CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being faxed to (703) 703-872-9326: Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 on September 29, 2005.

  
Laura L. Westin

Respectfully submitted,

KOLISCH HARTWELL, P.C.



Peter E. Heuser

Registration No. 27,902

Customer No. 23581

Attorney/Agent for Applicant(s)/Assignee

520 S.W. Yamhill Street, Suite 200

Portland, Oregon 97204

Telephone: (503) 224-6655

Facsimile: (503) 295-6679